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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/288,757

Applicant(s)

HOROWITZ ET AL.

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-18 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-12 and 19-27 is/are rejected.
- 7) ☒ Claim(s) 4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**SAM RIMELL**  
**PRIMARY EXAMINER**

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 apparently should depend from claim 4, since it recites “means for inputting a particular procedure”, which was first recited in claim 4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5, 7-10, 12, 19-21 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer et al.

Claim 1: Boyer et al. discloses a computer (16) which has standard input and output functions, as well as data storage means (32, 38, 40) in communication with the computer (16). First computers (12) located at provider offices allow the input of queries to the computer (16). Means associated with the computer (16) can provide a “real time” (col. 3, line 23) insurance eligibility determination (col. 13, lines 16-46). This eligibility determination involves the input of information (a diagnosis) and return of the available treatments which are covered by the insurance based upon the diagnosis information that was submitted. This determination is made in real time, without the need to send data from the data storage means (32, 38, 40) in advance of the determination. The provider may also submit a claim after the verification process, which constitutes a recording of the utilization of benefits. (col. 14, lines 6-13).

Claim 2: FIG. 1 illustrates the network of computers.

Claim 3: The computer are linked by the world wide web (Internet 14 in FIG. 1).

Claim 5: Queries submitted to the databases (32,38, 40) include a "Patient ID", which would inherently include unique identification information for a patient, such as the patient's name or social security number.

Claim 7-8: The utilization record is the claim for payment submitted after treatment (col. 14, lines 6-13). This record is accessible to third party payors, such as insurance companies.

Claim 9: Since the utilization record is the claim for payment, it will inherently include the provider, the patient being treated and the actual treatment.

Claim 10: The system of Boyer et al. is programmed such that the provider can select between the verification means (col. 13, lines 16-46) and the utilization recordation (claim creation described at col. 14, lines 6-44).

Claim 12: Information about a participant can be collected and updated prior to the verification process (col. 13, lines 8-12).

Claim 19: See remarks for claim 1.

Claim 20: The verification process occurs in real time (col. 3, line 23).

Claim 21: See remarks for claim 3.

Claim 23: See remarks for claim 7-8.

Claims 24-25: Connections to the Internet are inherently transient or permanent. An example of transient connection would be a connection by modem. An example of a permanent connection would be a data cable, such as a standard T1 line.

Claim 26: Participant data can be accessed by multiple providers simultaneously, as seen in FIG. 1. The data about participants is not sent to the participants in advance.

Claim 27: The eligibility determination process enables multiple providers to perform eligibility determinations simultaneously (See FIG. 1). The eligibility data is not sent to the provider in advance.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al. ('973).

Limiting access to data by authorized users by utilizing a login process is well known in the art for data security. It would have been obvious to one of ordinary skill in the art to modify Boyer et al. to require participants and third parties to log in for access to the available databases, so as to provide security for data in the databases as is well known in the art.

Claims 4 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13-18 are allowable over the prior art of record.

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Remarks

This office action is not made final. The reference to Boyer et al. is newly cited and is the only reference deemed applicable to the current claim set. Applicant's amendments and arguments have overcome all previous grounds of rejection.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
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